

Appl. No. 10/696,682  
Docket No. 9401  
Amdt. dated February 16, 2007  
Reply to Office Action mailed on January 16, 2007  
Customer No. 27752

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#### REMARKS

##### Claim Status

Claims 1-19 are currently pending.

Claim 20 is withdrawn without prejudice as being directed toward a non-elected invention.

##### Response to Restriction Requirement

#### I. Election of Inventions

The Examiner has required, under 35 USC §121, election of an invention corresponding to Claims 1-19 (Group I) and Claim 20 (Group II). Applicants provisionally elect Group I. The claim directed toward Group II has been withdrawn. This election is made with traverse.

The Office Action states that examination of both Groups I and II would be a serious burden on the Examiner. Applicants respectfully point out that the claim of Group II is directed toward a method of use of the compositions of Group I, and thus are related to Group I. Examination of all claims in both Group I and Group II would require little or no additional searching. Applicants respectfully request that this restriction requirement be withdrawn.

#### II. Election of Species

The Examiner has required, under 35 USC §121, election of a single disclosed species for each of the indicated claim elements 1-4 for prosecution on the merits. The Office Action states that the application contains the following patentably distinct species:

- 1) an anti-dandruff agent;
- 2) a ketoamide surfactant defining R1, R2, R3, R4 and R5;
- 3) a cationic polymer;
- 4) and either skin or hair for the purposes of the method claim.

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Traversal of Restriction Requirement

Applicants respectfully traverse, and submit that these requirements of an election of a single species are improper. Under MPEP §806.01, a provisional election of a single species may be required where only generic claims are presented and the generic claims recite such a multiplicity of species that an unduly extensive and burdensome search is necessary. Applicants respectfully assert that there is no undue burden placed on the Office in examining all original claims. However, to require election in each of the above categories would require Applicants to file as many as 15-20 divisional applications, which would place an unfair burden on Applicants.

Applicants assert that the above fail to meet the definition of patentably distinct species. According to MPEP 806(C): "Where inventions are related as disclosed but are not distinct as claimed, restriction is never proper" [emphasis added]. Elements (1) and (2) are elements of the first, patentable claim. Element (3) forms a dependent claim, from which a second, well-defined dependent claim depends. Thus, Applicants assert that the statement that (1) – (3) are patentably distinct species is incorrect, and further that they are not distinct, and restriction is improper.

37 CFR 1.141 (a) states:

Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, *provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form or otherwise include all the limitations of the generic claim.*

[Emphasis added]. Applicants reiterate that the combination of elements in the broadest claim generic to all the claimed species is allowable, and that all species in excess of one are written in dependent form. For example, in regard to the anti-dandruff agent, Applicants point out that separate dependent claims are directed to only three: a zinc salt of 1-hydroxy-2-pyridinethione, selenium sulfide and ketoconazole. 37 CFR 1.146 requires that the claims encompass a reasonable number of species. Certainly,

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three species is a reasonable number. The Office Action states that "the anti-dandruff agent varies in structure and have different properties." Applicants respectfully point out that all the agents have a similar property, namely, anti-dandruff activity. Furthermore, were it not the case that they vary in structure, all anti-dandruff agents would be the same and only one would exist.

In regard to the ketoamide surfactant, according to the MPEP:

[I]t is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature essential to that utility.

Here, the group shares a common utility, namely that of surfactant, and further share a substantial structural feature essential to that utility defined in claim 1. This is an easily searchable structure. R1-R4 are clearly defined and encompass a finite class of compounds comprising a reasonable number of structures. Applicants respectfully request that this restriction requirement also be reconsidered and withdrawn.

In regard to the cationic polymer, Applicants point out that this, too, represents a well-defined, easily searchable class of compounds and presents no serious burden in regard to searching the prior art. Applicants respectfully request that this restriction requirement also be withdrawn.

According to Patent Rule 37 CFR 1.146:

In the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted *if no claim to the genus is found to be allowable*.

[Emphasis added].

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Here, the broadest claims are allowable and further require no serious burden in searching the prior art. All of the claimed elements represent well-defined classes of compounds. To require election of a species within these classes would require Applicants to unduly and prematurely narrow the scope of the claimed invention, in some cases, to a single chemical compound. Applicants assert that this is inconsistent with the rules surrounding restriction requirements as set forth in the MPEP in that Applicants are being asked to significantly narrow claims before any art is identified that would require additional limitations.

To be in compliance with the requirements of the Office Action, Applicants elect provisionally and with traverse the following species:

- 1) For an anti-dandruff agent, Applicants elect the zinc salt of 1-hydroxy-2-pyridinethione of claim 7;
- 2) For a ketoamide surfactant, Applicants elect 1-[3-(2-Oxo-octadecanoylamino)-propyl]-pyridinium bromide of original claim 16;
- 3) For a cationic polymer, Applicants elect a guar derivative of original claim 18;
- 4) For the purpose of the withdrawn method claim 20, Applicants elect hair.

Applicants reserve the right to pursue the non-elected species in one or more divisional applications.

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Conclusion

The foregoing represents an earnest attempt at a provisional election of species. This election is made with traverse, and reconsideration and withdrawal of all restriction requirements is respectfully requested prior to issuance of the next Office Action.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By 

Juliet A. Jones  
Registration No. 54,202  
(513) 626-2127

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